REMARKS/ARGUMENTS

This letter is responsive to the Office Action mailed on December 21, 2008. A request for a one-month extension of time is being filed and accordingly the Applicant submits that this response is timely filed. This response is also accompanied by a Request for Continued Examination.

Claims 1, 3-10 and 12-26 are currently pending in the application.

The Applicant has amended independent claims 1 and 10 in order to clarify the distinction between the present application and the cited prior art references. Support for these amendments can be found in the present application from page 4, line 19 to page 5, line 2.

The Applicant has also introduced new claims 20-26.

Claims 1 to 19 rejected under 35 U.S.C. §103(a)

The Examiner has rejected claims 1 to 19 under 35 U.S.C. §103(a) as being unpatentable over Alleva et al., U.S. Patent No. 5,970,449, in view of Lu et al., U.S. Patent No. 5,410,475. Specifically, the Examiner has indicated that Alleva et al. teaches a configurable formatting system and method for generating a desired representation of an expression within a word list. The Examiner has further indicated that while Alleva et al. does not teach identifying the contextual state of a word, Lu et al. does so, and that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine these references.

The Applicant respectfully submits that the present claims are not obvious in view of Alleva et al. and Lu et al. Specifically, the Applicant submits that Lu et al. does not

disclose dynamically identifying the contextual state as recited in claims 1 and 10 of the present application, as amended.

In the present application, "the context of formatting system 10 dynamically changes as words are read from the word list 15. The context of formatting system 10 depends in part on whether a particular word just read is considered to be 'significant' or not." (present application, page 12, lines 11-14) Depending on the words on the word list, the context state of the formatting system can change with every word.

Further, the present application makes no assumptions regarding the content of the input word list 15. The words on the word list may occur in any context. The only limitation is that the group of words on the word list 15 occur in a phrase, as determined by a speech recognition application by examining the length of pause surrounding the group of words (present application, page 5, lines 14-24).

Specifically, in the example system described in the application two possible context states are used, NoCheck and WordInNumber, with specified conditions for the system to transition between context states. The translation of words from the word list into formatted words or expressions on the formatted word list depends critically on the context state of the system. For example, consider two sequences of words that could appear on the word list, "several centimeters" and "five centimeters." In one case we would like the formatted word list to contain the expression "several centimeters," without any change, while in the other case we would like the formatted word list to contain the expression "5 cm."

The context state of the system begins in the NoCheck context state but then subsequently, is dynamically determined in part by the word just read. In the first case, when "several" is read, it will be passed on to the formatted word list and the context state of the system will remain in NoCheck and "centimeters" will subsequently be translated as "centimeters," i.e. there will be no change. The formatted word list will contain "several centimeters." However, when "five" is read, the context state of the

system will change to WordInNumber and "centimeters" will subsequently be translated as "cm." The words "five centimeters" will ultimately be translated into the expression "5 cm" on the formatted word list.

In contrast, the context in Lu et al. is predetermined. Specifically, the context is "the name or caption of a lawsuit." (Lu et al., column 9, lines 47-48, see also column 9, lines 50-51). Lu et al. discloses a system and method for transforming a Long Case Name (LCN) into a Short Case Name (SCN). The preferred embodiment of Lu et al. processes LCNs in batches (Lu et al., column 4, lines 64-66 and FIG 3A number 308) and no mention is made of any ability or requirement to be able to distinguish an LCN from other sequences of words. No technique is suggested for how to distinguish an LCN from other groups of words.

Many of the rules for parsing a case name that are used in Lu et al. are derived directly from the predetermined context of the name or caption of a lawsuit. For example, one rule that Lu et al. posits that is useful in the predetermined context of a name or caption of a lawsuit is, "Neither the first nor the last word in an LCN can be 'versus.'" (Lu et al., column 9, lines 57-58). This rule is derived directly from the predetermined context of a name or caption of a lawsuit and makes little sense to apply outside this predetermined context. Lu et al. specifies many more rules of similar applicability: limited to the predetermined context of a name or caption of a lawsuit (e.g. see Lu et al., column 9, line 59 to column 12, line 27).

Accordingly, Lu et al. discloses the application of formatting rules, however elaborate, based on a predetermined context while the present application claims dynamically identifying the context state. The present application dynamically identifies the context of words making up an expression and applies different formatting rules to different words in a word list based on the identified context. For example, the present application can identify a change from the NoCheck context to the WordInNumber context, as described above. Lu et al. makes use of the known, predetermined context of an LCN and could not identify a change in context between an LCN and other words.

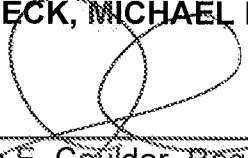
According to *KSR v. Teleflex* (550 U.S.__, 82 USPQ2d), the rationale to support a conclusion that the claim[s] would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art.

The Applicant respectfully submits that since neither Alleva et al. nor Lu et al. teach dynamically identifying the context state, the Examiner has not satisfied the initial burden of establishing a *prima facie* case of obviousness. The Applicant therefore further submits that claims 1 and 10 are not obvious in view of these references and that dependent claims 3-9 and 12-19 are similarly not obvious in view of the cited prior art.

The Examiner has also indicated that the Applicant's previously presented arguments with respect to claims 1, 7-10 and 15-19 are moot in view of the new grounds of rejection based on Lu et al. In view of the above, the Applicant submits that these arguments are not moot and respectfully requests that the Examiner reconsider these arguments with respect to claims 1, 7-10 and 15-26.

In view of the foregoing, the Applicant respectfully submits that the application is now in condition for allowance. Allowance of the application is respectfully requested. If the Examiner believes that a telephone interview would expedite allowance of the application, the Examiner is respectfully requested to contact the undersigned at (416) 957-1680.

Respectfully submitted,
LUECK, MICHAEL F.



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